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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,810	09/22/2003	Jurgen Stohrer	STOHRER ET AL-3	2169
25889	7590	07/17/2006	EXAMINER	
WILLIAM COLLARD COLLARD & ROE, P.C. 1077 NORTHERN BOULEVARD ROSLYN, NY 11576			CHANG, CELIA C	
			ART UNIT	PAPER NUMBER
			1625	

DATE MAILED: 07/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/667,810

Applicant(s)

STOHRER ET AL.

Examiner

Celia Chang

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. Amendment and response filed by applicants dated May 1, 2006 have been entered and considered carefully.
2. Claims 1-20 as currently amended are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. This is a NEW MATTER rejection.

Please note that the limitation as now incorporated in the claims “using from 2 to 5 mol equivalents of the hypohalite based on the number of functional groups to be oxidized” as found on page 23 is considered new matter. Please note that this limitation is for a batch process as described starting page 9 i.e. monophasic process with quantitative relationships. However, the process of claim 1, as originally filed is limited to a “continuous” process. The continuous process was described in the specification to be carried out with flow rated, temperature and metering during processing to maintain pH etc. on pages 28-31 and the limitation as now inserted was not described. Therefore, in view of a continuous maintenance of the inserted condition “using from 2 to 5 mol equivalents of the hypohalite based on the number of functional groups to be oxidized” is new matter. Description and enablement for *maintaining* such condition in the continuous adding process was not found.

Removal of all new matter is required. In re Russmussen 210 USPQ 325.

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3. Upon removal of new matter and the claims are restored to the previously amended form, the following rejections are maintained.

The rejection of claims 1-20 over Li et al. '573 in view of Anelli, deNooy, Harbeson, Brocheett, Thaburet or Merboouh '269 [and Fritz '371] is maintained. The filing of a certified translation entitled applicants to the priority benefit. However, even if Fritz '371 is not prior art it is supplemental and can be employed to "evidence" what is delineated clearly in the rejection which flow naturally from the prior art recited in the rejection. Please note that the Fritz '371 was provided as "evidence" that the guidelines as set forth in the decision from In re Fong 154 USPQ 25, In re Kronig 190 USPQ 425, In re Dillon 13 USPQ2d 1337 are "factual" because Fritz '371 showed that batch and continuous process are analogous even with analogous art. MPEP 2164.05(a) clearly allows post dated references to support the examiner's position which flows naturally from what is known in the art and follows the guidelines as concluded by the courts.

In addition, applicants argument with respect to stoichiometric vs catalytic amount of hypochlorite is misleading. Please note that the Li et al. '573 considered TEMPO as "catalyst" not hypochlorite. Especially at col. 5 , line 40, it was clearly disclosed that the invention was a process wherein TEMPO "catalyzed oxidation" with bleach. And at lines 61-63 it was said that bleach is believed to be the most likely candidate as an oxidant. The interpretation that when bleach or hypochlorite were recited with TEMPO is referring to bleach is being used in "catalytic" quantity is mis-interpretation of the reference. In addition, the term "using from 2 to 5 mol equivalents of the hypohalite based on the number of functional groups to be oxidized" will read on

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the Li et al. quantity. Please note that hypochlorite is the “choice” candidate of oxidant which participates in the reaction, thus, has to be stoichiometric, just as the amendments requires i.e quantity based on functional group to be oxidized.

4. Applicants are reminded again of the elected and examined scope being limited to TEMPO, 4-hydroxy-TEMPO, 4-oxo-TEMPO, 4-amino-TEMPO, 4-acetamido-TEMPO, 4-benzoyloxy-TEMPO, 4-acetoxy-TEMPO, in a two phase system. And please note that claim 1 is a continuous process as originally filed.

The broad scope has been withdrawn from consideration but would be rejection under 112 first paragraph or 102(f) over US 2004/0063932 as explained clearly in the previous office action. It has been clearly explained that each catalyst has different activity and property and no support can be found that all nitroxy catalyst can be added to have operability as 4-hydroxy TEMPO found in the continuous example of the disclosure example 4. It is well known to one skilled in the art that the catalyst art is highly unpredictable.

It is recommended that the elected invention be incorporated in the claims.

5. The rejection of claims 1-20 under the judiciary created doctrine of obviousness type double patenting over SN 10/365,887 is dropped in view of the abandonment of the application without filing of continuations.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Celia Chang whose telephone number is 571-272-0679. The examiner can normally be reached on Monday through Thursday from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas McKenzie, Ph. D., can be reached on 571-272-0670. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

OACS/Chang
July 7, 2006



Celia Chang
Primary Examiner
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